

### REMARKS

Applicants respectfully request that the enclosed amendments to the instant application be entered prior to taking action on the instant application.

#### Remarks re: Specification amendments

The above amendment to the specification moves a section of text entitled "Related Application Data" from its original location before the section entitled "Cross Reference to Related Application" to a location immediately after it. Note that no actual changes in any of the text in the section entitled "Related Application Data" were made. This moving of a section was done so that the cross-reference to the priority applications will appear as the "first sentence" of the application, as recommended in MPEP section 201.11. No new matter is added by this change, as the priority claims were already present in the application as filed and were already listed in the Application Data Sheet accompanying the application as filed.

Two minor changes were made in the section entitled "Cross Reference to Related Application." The first minor change is to make all of the priority claims part of a single sentence (rather than two separate sentences) by deleting the period at the end of the first sentence, adding the word "and" and deleting the first two words ("This application") of the following sentence. MPEP 2163.07 states that such "mere rephrasing" in a passage does not constitute new matter.

The second minor change is to fill in the actual serial number of one of the priority applications. At the time of filing of the instant application (September 30, 2003), the serial number of one of the cases to which the instant case claims priority was listed as "not yet assigned," as Applicant had not yet received back a serial number from the United States Patent and Trademark Office (Note that this priority case had been filed just a week and a half earlier (on September 19, 2003) than the filing of the instant case (September 30, 2003)). Applicant had nonetheless identified the priority application with as much particularity as known at the time of filing. At the present time, the serial number of this priority case is now known to be serial number 60/504,352, so this number has been filled in by amendment to replace the "not yet

assigned” text that was in the original application. No new matter has been added by the above amendment.

Remarks Re: Drawing Amendments

In the Notice to File Missing Parts of Nonprovisional Application dated 12/23/2003 and issued in the instant case, it was noted that certain figures (namely, FIGs. 9A, 9B, 10A, 10B, 11A, 11B, 12A, 12B, 13A and 13B), described in the Specification, appeared to have been omitted. By way of explanation in response to this Notice, the instant application as filed was inadvertently filed with the wrong set of drawings—the erroneous drawings that were filed were a set of drawings associated with another application filed by the assignee of the instant application having a close docket number (P0890D) to that of the present application (P0889D). Despite this inadvertent error, Applicant maintains that the replacement set of drawings provided herein by amendment (FIGS. 1-13B) DOES NOT CONSTITUTE NEW MATTER, as explained below.

First, although the set of drawings originally filed are incorrect and do not correspond to the corresponding text in the Specification, each figure in the set of replacement drawings, (FIGS. 1-13B) attached hereto was, in fact, already described in the application with particularity and detail at least at pages 5-6, 19, 32, 38-47, 56, 59, 62-64, and 68-69. This replacement set of drawings corresponds exactly, in every detail, to FIGs. 1-13B as described in the application as filed, at the above pages. MPEP 2163.07 states that “*Amendments to an application which are supported in the original description are NOT new matter*”.

Second, the attached set of replacement drawings (FIGS. 1-13B) were, effectively, already part of the application as originally filed, because such drawings are part of a priority document that was expressly incorporated by reference in the application as filed. Specifically, FIGS. 1-13B were already filed in another patent application (namely, the case entitled “Laser Engraving Methods and Compositions, and Articles Having Laser Engraving Thereon”) that itself was expressly incorporated by reference into the instant application. This incorporation by reference was mentioned in the Cross Reference to Related Application Section of the application as filed at page 2, lines 3-10 (these lines are replicated as follows):

“This application claims the priority of the following United States Provisional Applications, the contents of which are incorporated hereby by reference in their entirety:

- Identification Document (Application No. 60/471,429, Attorney Docket No. P0833D, filed May 16, 2003—Inventors Robert Jones, Brian Labrec, Daoshen Bi, and Thomas Regan);
- Laser Engraving Methods and Compositions, and Articles Having Laser Engraving Thereon (Application No. not yet assigned, Attorney Docket No. P0888D, filed September 19, 2003—Inventors Brian Labrec and Robert Jones); and”

Note that MPEP 201.06(c) states in its “Incorporation by Reference” Section:

*A priority claim under 35 U.S.C. 120 in a continuation or divisional application does not amount to an incorporation by reference of the application(s) to which priority is claimed.*

*For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application*

Applicant satisfies MPEP 201.06(c) in every regard. As seen above, Applicant had expressly claimed priority to the application entitled “Laser Engraving Methods and Compositions, and Articles Having Laser Engraving Thereon” (now known to having application serial no 60/504,352). As MPEP 201.06(c) also states, the express incorporation by reference of the contents of the priority document, in the application as filed, is sufficient to permit:

*the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition*

For at least the reasons detailed above, Applicant thus maintains that MPEP 201.06 and MPEP 2163.07 permit the entering, in this amendment, of the inadvertently omitted drawings, without need for a petition and without loss of priority or of filing date.

Concluding Remarks

As explained above, no new matter has been added by the amendments made herein. An early and favorable action on this application is respectfully requested. Should there be any questions on this amendment and/or the instant application, please feel free to telephone the undersigned.

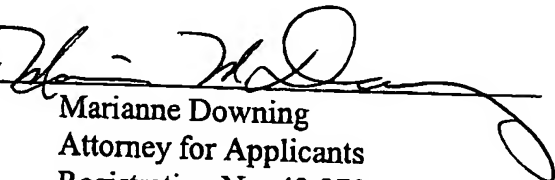
Date: May 24, 2004

Customer Number: 23735

Telephone: 781-744-6404  
Alternate Telephone: 503-885-9699  
FAX: 781-744-6741  
Alternate FAX: 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

By   
Marianne Downing  
Attorney for Applicants  
Registration No. 42,870